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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,658	11/16/2000	Mark D. Gehlsen	53786USA5B.012	5668

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/714,658	Applicant(s) GEHLSSEN ET AL.	
	Examiner Victor S Chang	Art Unit 1771	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached NOTE.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-26,29-32,34-36,49,50 and 55-60.

Claim(s) withdrawn from consideration: 43,47,48 and 51-54.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: PTO-892, Notice of References Cited.

**DANIEL ZIRKER
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Daniel Zirker

NOTE

1. The After Final Amendment is not entered. It is noted that the newly amended claim 1, lines 3-4, now recites in part "said polymer foam being smooth without being bonded to an additional layer" (Amendment, page 1). While such amendment appears to overcome the rejection over the prior art, it clearly raises new issues that would require further consideration and/or search, and it should be submitted in a timely re-filed application, i.e., a CPA or RCE.

2. With respect to Applicants' argument that "claim 1 has been amended ... without being bonded to an additional layer" (Response, pages 1-2, bridging paragraph), the Examiner notes that the amendment clearly raises new issues, and has not been entered as set forth above.

3. With respect to Applicants' argument that "Figure 1 is only a representation of the invention disclosed in US '712" and "US '712 repeatedly teaches that the surfaces of the foam itself are not smooth ..." (Response, page 3, second full paragraph), the Examiner repeats (see Paper No. 11, page 5) that Hartman expressly teaches that "the skin provides the carrier with a smooth face" (column 3, lines 18-19), and that in Fig. 1, Hartman illustrates that the surfaces of the foam article are parallel to the flat or smooth surfaces of the skin layers and adhesive layers (see page 2 of Paper No. 8). It should be noted that attorney's arguments are not factual evidence required to rebut a *prima facie* case of obviousness, and must be supported by an appropriate affidavit or declaration. See MPEP § 2145.I.

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4. With respect to Applicants' argument that "the die used in US '712 is designed such that the pressure drops outside the die. Consequently, the microspheres are not expanded until the molten material exits the die" (Response, pages 3-4, bridging paragraph), the Examiner notes again that Attorney statements are not evidence and must be supported by an appropriate affidavit or declaration. See MPEP § 2145.I.

5. With respect to Applicants' argument that "a tackifier would need to be added to the A-B-A triblock thermoplastic elastomer to form a pressure sensitive adhesive (Response, page 6, first paragraph), the Examiner notes again that Attorney statements are not evidence and must be supported by an appropriate affidavit or declaration. Further, while it is known that a tackifier is typically added to modify the adhesiveness of a triblock copolymer, nonetheless a triblock copolymer inherently encompasses pressure sensitive adhesives such as a styrene-isoprene-styrene or styrene-diolefin triblock copolymers, as evidenced by the teaching of JP 62087858 (English Abstract), or Angelopoulos et al. (US 5645764, column 3, lines 50-53). It should be noted that a *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification. See MPEP § 724.

6. Applicant's arguments with respect to claims 7, 8 and 18 (Response, page 7) have been considered but are moot in view of the fact that a triblock copolymer inherently encompasses a pressure sensitive adhesive as set forth above.

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7. Regarding claims 13-16, it is noted that Applicants continue to argue the smoothness of the foam surface (Response, pages 8-9), Examiner reiterates that Attorney statements are not evidence and must be supported by an appropriate affidavit or declaration, as set forth in section 4.

8. Regarding Applicants' argument that "Sieverding does not disclose adhesives that are capable of stretch activated release as the phrase is used in the present application" (Response, page 9, 4th full paragraph), the Examiner repeats (see Paper No. 8, section 8) that Sieverding's invention is directed to thick pressure sensitive adhesive films comprising a homogeneous mixture based on 100% of the solids weight of the adhesive film of a triblock copolymer or in combination with a diblock copolymers (Abstract). A particularly preferred triblock copolymer is KratonTM of an ethylene-1-butylene copolymer elastomer containing polystyrene end polymer groups, i.e., SEBS, as shown in Table I (column 2, lines 35-60). The adhesive films can be made by hot melt extrusion process (column 11, lines 57-60). Further, the adhesive film can be separated from the adhering surfaces and reshaped and used again as a pressure sensitive adhesive, i.e., stretch releasable (column 7, lines 46-50). Further, Applicants appear to argue that claims 55 and 56 are limited to stretch release adhesive disclosed in US 557464 (Response, page 9, 5th paragraph), the Examiner notes that claims 55 and 56 are not so limited. It should be noted that although the claims are interpreted in light of the specification, limitations from the Specification are not read into the claims. See MPEP § 2145.VI

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9. Applicants' request to withdraw the finality of the prior Office action as being premature is not persuasive. It is noted that Applicants' argue that not each and every element recited in claims 23-32 and 34-36 can be found in US '712, the Examiner notes that US '712 does teach each and every element, including the triblock copolymer, as set forth above.